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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,672	03/04/2005	Hisashi Maeshima	3273-0208PUS1	3246
2292 7590 09/05/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
SELLERS, ROBERT E				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
09/05/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/526,672

Applicant(s)

MAESHIMA ET AL.

Examiner

ROBERT SELLERS

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 6-29 is/are pending in the application.
- 4a) Of the above claim(s) 6-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

This is responsive to the Request for Continued Examination filed August 22, 2008 based on the claims filed July 22, 2008.

Claims 6-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected inventions, there being no allowable generic or linking claim. The election was made **without** traverse in the reply filed on November 15, 2007.

The basis for the non-statutory obviousness-type double patenting and the text of section 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection mailed December 10, 2007.

1. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of copending application no. 10/567,253 in view of the references set forth hereinbelow.
2. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5 and 6 of copending application no. 10/883,162 in view of the following references:

Yur've et al. article as disclosed in HCAPLUS accession no. 1972:526335,
German Patent No. 1,418,465,
Japanese Patent No. 54-3006 (Japanese '006),
Hau article translation,
Japanese Patent No. 5,239043 (Japanese '043), and

Harano et al. Patent No. 5,494,977.

These are provisional obviousness-type double patenting rejections.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Yur've et al. article in view of the other references presented hereinabove.
4. The rejections are maintained for the reasons of record espoused in the previous Office actions except for the newly claimed molar ratio of organic percarboxylic acid to unsaturated groups in the alicyclic diolefin compound of from 1.0:1 to 3.0:1 as supported by page 28, lines 5-7 of the specification.
5. Harano et al. teaches the epoxidation of compounds having side chain vinyl groups (col. 10, lines 48-53) with an epoxidation agent such as preferably peracetic acid (col. 10, lines 59-61) at a preferred molar ratio of peracetic acid to the unsaturated bonds of from 1:1 to 5:1 (col. 11, lines 38-49).
6. It would have been obvious to prepare the alicyclic diepoxides of the copending applications and to epoxidize the bi-3-cyclohexen-1-yl of Yur've et al. utilizing peracetic acid at a molar ratio relative to the unsaturated bonds of from 1:1 to 5:1 reported in Harano et al. in order to economize the epoxidation and to mitigate the onset of side reactions.

(571) 272-1093 (Fax No. (571)-273-8300)
Monday to Friday, 9:30 to 6:00

/Robert Sellers/
Primary Examiner
Division 1796

rs
8/30/2008